



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,739	02/20/2004	Satosi Imago	249090US2	3599
22850	7590	06/19/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
NOTIFICATION DATE		DELIVERY MODE		
06/19/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/781,739

Applicant(s)

IMAGO, SATOSI

Examiner

MARK FADOK

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-13 and 16-50 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12 and 23-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 10, 13, 16-20, 23 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The examiner is in receipt of the response to office action mailed 12/31/2008, which was received 3/30/2009. Acknowledgement is made that there were no amendments to the instant claims. Applicant's arguments and amendments have been carefully considered and were found convincing, however, after review of the IDS, the following new ground of rejection is provided as necessitated by amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10, 13, 14-18, 23, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,421,716 in view of Japanese Patent 2002-07421 to Susumu (see translation in PTO 892) and further in view of Bettstetter (an article from PTO 892).

Referring to claims 1-7, 10, 13, 14-18, 23, and 50: Eldridge teaches a service information providing apparatus comprising: a service providing part configured to provide a service which a user utilizes (*col. 4, lines 24-36; col. 10, lines 4-10*), wherein said

service providing part further includes a service information providing part configured to provide information concerning the service in response to a request from a user terminal to the user terminal (*col. 4, lines 24-36; col. 10, lines 4-10*),

Eldridge teaches selecting a service from a requested information on services and using well known network communication protocols such as TCP (FIG 4A), but does not specifically mention that the service information returned includes port number of the end point service. Susumu teaches the use of Service location protocol to access and gather information about a printers service profile (para 0032). Bettstetter discusses how SLP is used to search for available service, choose the right service and utilize the service (page 1). Bettstetter further teaches the service URL contains the IP address of the service, the port number, and path. Service templates specify the attributes that characterize the service and there default values (page4). It would have been obvious to a person having ordinary skill in the art a the time of the invention to include in Eldridge, the use of SLP to gather information and execute the use a service based on the retrieved data as is taught by Susumu and Bettstetter, because SLP is a known open source means that provides efficient service discovery in self organized or ad hoc networks where a user may come to an unknown network environment with a mobile device and then detect available services according to ones needs.

an implementation type of the service (*Figure 8, "804": "COLOR PRINT SERVICES; SCAN SERVICES"*) and enabling the user to utilize the service when selected, and

wherein the service is configured to operate a hardware resource which performs image formation (*col. 10, line 39 – col. 11, line 25*).

wherein said service information providing part includes a service information obtaining part obtaining the information concerning the service from a service information storing part storing the information concerning the service (*col 8, lines 24-35*), and

wherein the request includes a search condition, and said service information providing part further includes a determining part based on the search condition whether or not the information concerning the service obtained by said service information obtaining part is information concerning the service required by the request (*col 11, searches database for services that are available in the area of the device*).

Claims 8 and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,421,716 B1) (“Eldridge”) in view of Susumu and Bettstetter and further in view of Parasnis (US 7,284,199).

In regards to claims 8 and 19, Eldridge teaches converting documents into appropriate format (*col 5, lines 5 and 6*) and returning information to a user for interpretation and selection by the user (*FIG 5-13*), but does not specifically mention that the information is provided in a preferred language based on the language indication information. Parasnis teaches providing responses in a selected language

(col 7, lines 40-65). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Eldridge providing information in a selected language because information provided while in a foreign country would not require a grasp of the language and allow the user to order documents in that country in a fast and efficient manner as though they were in the home country.

Claims 9, and 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,421,716 B1) ("Eldridge") in view of Susumu and Bettstetter.

Referring to claim 8, 9, 19 and 20: The cited prior art discloses or suggests all the limitations of claims as noted above. The cited prior art does not teach that the information concerning the service includes at least one of a name of the service, a name of an apparatus providing the service, icon information concerning the service. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the apparatus would be the same regardless of what language the service was written in. The difference between the claimed invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was

made to include in the service of Eldridge in any information concerning the service because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 4/24/2009 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Application/Control Number: 10/781,739

Page 8

Art Unit: 3625

Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625